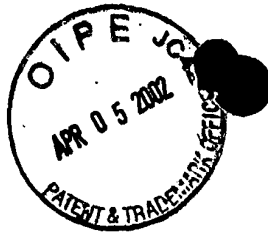


Patent



Attorney Docket No.: 13025-6

#35/8
CD
4/17/02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re New Continued Prosecution Application:

Prior Application:

Applicants: Soderlund, Hans E. and
Syvanen, Anne-Christine

) Examiner: Carla J. Myers

)

)

Group Art Unit: 1655

Serial No.: Unassigned

)

)

Filed: Herewith

)

)

For: " Reagent Kit for Determining Specific
Nucleotide Variations "

)

)

Kalow & Springut LLP
488 Madison Avenue, 19th Floor
New York, New York 10022

5 April 2002

Commissioner for Patents
Box CPA
Washington, DC 20231

PRELIMINARY AMENDMENT

SIR or MADAM:

Prior to calculation of the filing fee and examination on the merits, please amend the new continued prosecution ("CPA") identified above as follows:

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Notice Regarding Filing of Correspondence by
"Express Mail" Pursuant to 37 CFR 1.10

"Express-Mail" mailing label number: EV 035773986 US
Date of Deposit: 5 April 2002

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In the Title:

Please amend the title of the application to read: --Reagent Kit for Determining Specific

G1 Nucleotide Variations--

In the Claims:

Please cancel claims 70 and 76 through 96 inclusive, without prejudice.

Please amend claims 51, 56, 57, 59 and 62 to read as follows:

G2 51. [Five times amended] A reagent kit for detecting the presence of a specific nucleotide at a predetermined position in a target nucleic acid polymer, comprising: a polymerizing agent; at least one deoxynucleotide and at least one chain terminating nucleotide analogue; and an oligonucleotide detection primer having a nucleotide sequence complementary to and capable of hybridizing to a region in the target nucleic acid polymer flanking the 3' end of a predetermined position, such that the oligonucleotide detection primer, when hybridized to the target nucleic acid polymer, forms an oligonucleotide detection primer extension product by an enzyme catalyzed chain extension nucleic acid polymerization, wherein at least one deoxynucleotide comprises a detectable label.

G3 56. [Three-times amended] A reagent kit according to Claim 51, wherein the detection primer has the sequence 5' -GTA CTG CAC CAG GCG GCC GC-3'.

57. [Three-times amended] A reagent kit according to Claim 51, wherein the detection primer has the sequence 5' -GGC CTG GTA CAC TGC CAG GC-3'.

G4 59. [Three-times amended] A reagent kit according to Claim 51, wherein the detection primer has the sequence 5' -CAG TAA CGG CAG GCG GCC GC-3'.

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62. [Three-times amended] A reagent kit according to Claim 51, wherein the detection
primer has the sequence 5'-AAC TTG TGG TAG TTG GAG CT-3'. - -

Pursuant to 37 CFR 1.121(c) (1)(ii), a copy of the amended claims marked up to show added matter by underlining and deleted matter in square brackets is attached as Appendix A.

REMARKS

The present preliminary amendment is being filed simultaneously with a new continued prosecution application based on United States patent application Serial No. 08/465,322, filed on 5 June 1995 and having the title "Method and Reagent for Determining Specific Nucleotide Variations" ("the parent '322 application").

An Office Action dated 2 March 2001 was issued in connection with the parent '322 application in which claims 51 through 53 inclusive, 56, 57, 59, 62, 63, 67, and 70 through 75 inclusive were finally rejected and claims 76 through 96 inclusive were made subject to a restriction requirement and withdrawn from consideration. The final rejection of the claims was appealed in a notice of appeal timely submitted to the United States Patent and Trademark Office with a certificate of mailing pursuant to 37 CFR 1.8 dated 4 September 2001. The appeal was dated 7 September 2001. A request to extend the time to file an appeal brief in the appeal with respect to the parent '322 application through 7 April 2002 is being submitted with the subject continued prosecution application. Consequently, the subject continued prosecution application is being filed before abandonment of or termination of proceedings with respect to the parent '322 application, as required under 37 CFR 1.53(d)(ii).

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In the present preliminary amendment, dependent claim 70 has been cancelled without prejudice and independent claim 51 upon which claim 70 depended has been amended to incorporate the limitations of claim 70. It is submitted that the amendment to claim 51 does not incorporate new matter and that, as amended, claim 51 is of identical scope to original claim 70.

Claim 56, 57, 59, and 62 have been amended with comments in mind concerning rejection of those claims under 35 U.S.C. §112, second paragraph, in the Office Action of 2 March 2001. It is submitted that the amendments to claims 56, 57, 59, and 62 do not constitute new matter and do not alter the scope of the original claims as those claims would have been understood by a person of ordinary skill in the art.

Method claims 76 through 96 of the parent '322 application, which were made subject to a restriction requirement in the Office Action of 2 March 2001, have been cancelled without prejudice in the present preliminary amendment. The applicants expressly reserve the right to prosecute claims to subject matter of any or all of cancelled claims 76 through 96 inclusive in one or more continuation, divisional, continued prosecution, or other continuing application.

Entry of the present preliminary amendment and early allowance of the subject application is respectfully requested.

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No fees are believed to be required in connection with the filing of the present preliminary amendment. However, if any fee is deemed necessary, the Patent and Trademark Office is hereby authorized to charge the amount of such fee to Deposit Account No. 11-0171.

Respectfully submitted,

Attorneys for the Applicants

by

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APPENDIX A
Marked-Up Amended Claims

51. [Five times amended] A reagent kit for detecting the presence of a specific nucleotide at a predetermined position in a target nucleic acid polymer, comprising: a polymerizing agent; at least one deoxynucleotide and at least one chain terminating nucleotide analogue; and an oligonucleotide detection primer having a nucleotide sequence complementary to and capable of hybridizing to a region in the target nucleic acid polymer flanking the 3' end of a predetermined position, such that the oligonucleotide detection primer, when hybridized to the target nucleic acid polymer, forms an oligonucleotide detection primer extension product by an enzyme catalyzed chain extension nucleic acid polymerization, wherein at least one deoxynucleotide comprises a detectable label.

56. [Three-times amended] A reagent kit according to Claim 51 [having] , wherein the detection primer has the sequence 5' -GTA CTG CAC CAG GCG GCC GC-3'.

57. [Three-times amended] A reagent kit according to Claim 51 [having] , wherein the detection primer has the sequence 5' -GGC CTG GTA CAC TGC CAG GC-3'.

59. [Three-times amended] A reagent kit according to Claim 51 [having] , wherein the detection primer has the sequence 5' -CAG TAA CGG CAG GCG GCC GC-3'.

62. [Three-times amended] A reagent kit according to Claim 51 [having] , wherein the detection primer has the sequence 5' -AAC TTG TGG TAG TTG GAG CT-3'.